

REMARKS/ARGUMENTS

Claims 1-36 are pending in the application.

Restriction to one of the following inventions is required under 35 U.S.C. 131:

- I. Claims 1-20 and 27-29, drawn to products of Formula I, classified in class 544/1+; 546/272.7+; and 548/311.1+.
- II. Claims 21-23, drawn to process of making products of Formula I, classified in class 544/1+; 546/272.7+; and 548/311.1+.
- III. Claims 24-26, drawn to products of Formula II, classified in class 546/272.7+; and 548/311.1+.
- IV. Claims 30-36, drawn to method of use, classified in class 514, subclass 183+.

Applicants elect the subject matter of the Examiner's Group I for further prosecution in this application. This election is made with traverse.

The Examiner has requested applicants to elect a single disclosed species from whichever group is ultimately elected. As the elected species applicants elect the compound 4-[4-(4-fluorophenyl)-2-[(E)-(1-ethyl-2-pyrrolidinylidene)methyl]-1-(3-phenylpropyl)-1H-imidazol-5-yl]-pyridine, compound 2. The structure for this compound is found in claim 20 and the compound name is listed in Example 2 on Page 25 of the specification.

In requiring restriction the Examiner has concluded that the inventions are distinct because the products of Group I and Group III differ materially in structure and element so much so as to be patentably distinct and because a reference which anticipates one Group may not render obvious the other Group.

The claims in Group I are drawn to compounds of Formula I while the claims in Group III are drawn to compounds of Formula II. The compounds of Group III are intermediates in the synthesis of the compounds of Group I. The compounds in each Group differ from each other in terms of the grouping attached to the five membered ring. Given the close relationship between the two sets of compounds, i.e. product and intermediate, it seems to be practical and desirable to include all of the compounds in the same application. As a practical matter the Examination of the compounds in one application would not be an undue burden on the Examiner since they are classified in the same classes in the Patent Office classification system. The fact that a reference anticipating one group may not render the other obvious has no bearing on the restriction requirement since the reverse may also be true. It is submitted that the groups are not so distinct from each other as to require restriction between them.

The inventions of Group I and Group II are related as process of making and product made. The Examiner justifies the requirement by concluding that the claimed process can be used to make other and materially different products.

According to the section of the MPEP referred to by the Examiner [(MPEP § 806.05(f)] "A process of making and a product made by the process can be shown to be distinct inventions if either or both of the following can be shown: (A) that the process as claimed is not an obvious process of making the product and the process as claimed can be used to make other and different products; or (B) that the product as claimed can be made by another and materially different process." Applicants believe that the section referred to by the Examiner applies to those situations where the product is defined by the process by which it can be made [MPEP.05(f)]. In the present application applicants have claimed the product per se in claims 1-20 and 27-29. The section relied upon by the Examiner, therefore, is not applicable to applicants product claims.

The inventions of Group I and Group IV are related as product and process of use. The Examiner has concluded that restriction is proper because the process for using the product as claimed can be practiced with another materially different product. The compounds of the present invention are useful in the treatment of diseases associated with the overproduction of inflammatory cytokines. Even though the claimed process for using the claimed product can be practiced with a materially different product, it seems practical, to include claims to the products and their method of use in the same application.

Applicants submit that the inventions of Groups I, II and III are not so distinct from each other as to require restrictions among them. The fact that the inventions of Groups I, II and III are classified in the same classes is an indication that they have not acquired a separate status in the art as indicated by the Examiner. For these reasons, it would not impose an undue burden on the Examiner and the Patent Office resources to examine the inventions of Groups I, II and III in one application. As indicated by the Examiner, only the inventions of Group IV require searches different from the searches for Groups I, II and III. Since the inventions of Groups I, II and III are classified in the same classes, as indicated by the Examiner in the restriction requirement, it is submitted that it would be proper to search the inventions in Groups I, II and III in the same application.

Applicants take note of the fact that, in the event a product claim is found allowable, withdrawn process claims that depend from or otherwise include all of the limitations of the allowable product claim will be rejoined in accordance with the provisions of MPEP § 821.04.

Reconsideration of the requirement for restriction is courteously requested.

Respectfully submitted,

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